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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/242,210	11/04/1999	LINDA V GRAVELL	E-731	9775

7590 11/24/2003

CHARLES R MALANDRA JR
PITNEY BOWES INC
INTELLECTUAL PROPERTY AND TECHNOLOGY LAW DEP
35 WATERVIEW DRIVE PO BOX 3000
SHELTON, CT 06484

EXAMINER

SHERR, CRISTINA O

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 11/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/242,210

Applicant(s)

GRAVELL ET AL.

Examiner

Cristina O Sherr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 9-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 9-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 6) ☐ Other: _____

1. This communication is in response to Applicant's Response filed 2 September 2003 and received 6 September 2003. Claims 1, and 9 – 18 are pending in this case.

Claim Rejections - 35 USC § 102

Response to Arguments

2. Applicant's arguments have been considered and are not persuasive.

3. Applicant argues with respect to Claim 1, that Kara (US 5,882,739A) does not provide for a "digital signature" to authenticate and protect the integrity of the information packet. Examiner respectfully disagrees and calls attention to col 14, ln 12-36 as well as col 4, ln 37 – 50.

4. Applicant further argues with respect to claims 9 – 18 that Whitehouse (US 6,005,945A) does not disclose signing a transaction record, associated with generating the digital token and storing the signed transaction record in the storage device of the data center. Examiner respectfully disagrees and calls attention to col 8 ln 37 – 41 and col 14 ln 26 – 48.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

6. A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Kara (US 09/5,822,739).

8. Kara discloses a method for evidencing postage on a mail piece comprising the steps of receiving at a data center postal information relating to a mail piece, said postal information including recipient address information for the mail piece (col. 6, lines 34-38; col. 8, lines 24-29); generating a digital token for the mail piece, said digital token including encrypted information for the mail piece based on said recipient address information (col. 8, lines 24-29; col. 14, lines 25-67); creating a transaction record, said transaction record including the digital the token and the postal information (col. 14, lines 29-36); signing the transaction record (col. 14, lines 30-36; i.e., a transaction record having "a unique transaction identifier"); storing the transaction record in a database (col. 14, lines 12-24); and performing value added services using the transaction record (col. 14, lines 39-41).

9. Claims 9-18 are rejected under 35 U.S.C. 102(e) as anticipated by Whitehouse (US 09/6,005,945).

10. Whitehouse discloses a system and method comprising a data center (102) communicatively coupled to a remote computer (104) via a network (e.g., Internet), a user initiating a request to the data center via the remote processor (110) to dispense postage value to be printed by a printer (108) coupled to the remote processor (110), the data center comprising a storage device (174) to store the user accounts (col. 8, lines 56-57) or meter accounts, and a first cryptographic module (161) coupled to the storage device (col. 12, lines 57-64) to verify the digital signature of the user.

11. Whitehouse further discloses a second cryptographic module (164) coupled to the storage device including keys to generate a digital token (col. 8, lines 38-41 or col. 11, lines 27-29), a key to decrypt a token key included in the meter account (col. 9, lines 35-39), a transaction record (e.g., amount of transaction) and a user transaction record (e.g., second transaction table record), coordinating encryption/decryption to keep the integrity of the balance update transaction (col. 14, lines 25-28, lines 43-46), the data center sends the digital token to the remote processor via the Internet, a key management system (col. 18, line 41), on-line rating (col. 24, lines 1-11), and on-line tracking of all postal transaction processed by the data center (col. 8, lines 59-62).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 9-18 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Whitehouse (US 09/6,005,945).

14. Whitehouse does not explicitly disclose the use and locations of the first, second, third and fourth keys. However, Whitehouse clearly states the use of a key encryption method to secure the transactions and it would have been obvious to employ any number of keys as needed depending on the steps that the protection is desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Further, it

would have been obvious to one having ordinary skill in the art at the time the invention was made to locate keys at any desirable modules, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Conclusion

15. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

16. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina O Sherr whose telephone number is 703-305-0625. The examiner can normally be reached on Monday through Friday 8:30 to 5:00.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

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19. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

A handwritten signature in black ink, appearing to read "Vincent Millin". The signature is stylized with a large, looped "V" and a cursive "Millin".

VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600